

Docket No.: 041-1987

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Satoshi BAN et al.

Serial No. 09/003,812

Filed: 01/07/1998

:  
:  
:  
:  
:  
:

Group Art Unit: 2644

Examiner: GRIER, LAURA A.

For: MULTIPURPOSE EARPHONE SET (as amended)

**REQUEST FOR WITHDRAWAL OF IMPROPER OFFICE ACTION AND FOR  
ISSUANCE OF CORRECTED ACTION**ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

Dear Sir:

On October 3, 2001, applicants had filed an Amendment in the above identified application.

The amendment provided the following changes in the claims:

- 1) claims 1, 4 and 6-7 were cancelled; and
- 2) claims 8-10 were added.

On December 21, 2001, an Office Action was mailed, which Action did not properly or consistently address the above noted amendment.

As will be demonstrated in the following, the Action rejects claims already cancelled, asserts that cancelled claims are pending in the application, contends that cancelled claims are withdrawn from consideration, inconsistently addresses the added claims, and causes confusion as to the manner of providing an appropriate response thereto.

Serial No. 09/003,812

Request

Based on the errors in the Action, a corrected Office Action is requested, having a reset time for response. It is requested that the corrected Action properly address and identify the claims actually pending in the application. Such a corrected Action will permit applicants a proper opportunity to respond thereto, and to obtain correction of the files of the USPTO if necessary and to amend the actually pending claims, if necessary.

Factual Basis for Request

It is noted, for example, that the Office Action Summary states that claims 1-10 are pending in the application, and that claims 1, 4, 6 and 7 have been withdrawn from consideration.

It is thus unclear to applicants whether or not the amendment of October 3, 2001 was entered fully or in part, as that amendment requested that claims 1, 4, 6 and 7 be "cancelled without prejudice or disclaimer."

If the Summary is correct, and claims 1, 4, 6 and 7 are still pending, then applicants are at a loss as to why these claims were withdrawn from consideration and whether or not to traverse such withdrawal, to amend the claims, to conclude that those claims should be filed in a divisional application, or to conclude that these claims should be considered allowable.

Moreover, if the Summary is correct that only claims 1-7 are rejected, applicants are at a loss as to whether claims 8-10 added on October 3, 2001, are in fact allowable but rejected in the body of the Action through typographical error, and as to whether claims 1-7 (including the claims "withdrawn from consideration") are in fact pending and

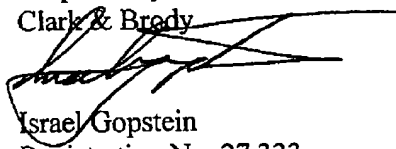
Serial No. 09/003,812

rejected but omitted from the body of the Action through the same or another typographical error.

In view of the foregoing, it is respectfully requested that:

- 1) A new Official Action be provided by the Examiner which properly addresses the status of the claims at the time the present Action was mailed; and
- 2) The response time be restarted in view of the above noted deficiencies in the Action dated December 21, 2001.

Respectfully submitted,  
Clark & Brody

  
Israel Gopstein  
Registration No. 27,333

1750 K Street, N.W. Suite 600  
(202) 835-1111  
(202) 835-1755 (fax)  
March 21, 2002

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Fax no. (703) 872-9314, on the date shown below.

March 21, 2002

  
Israel Gopstein Registration No. 27,333